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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,872	03/12/2001	William Coan	12177/44301	5649

23838 7590 04/05/2004

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EXAMINER	
ESCALANTE, OVIDIO	

ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/802,872	COAN ET AL.	
	Examiner	Art Unit	
	Ovidio Escalante	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 March 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings submitted on June 7, 2001 were received and accepted by the Examiner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1,2,12,13,24,25 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Dusse US Patent Pub. 2002/0068554.

Regarding claim 1, Dusse teaches a method for providing enhanced services at a mobile communication device, (abstract; paragraph 11), comprising:

defining a service having a superset of features, (paragraphs 11 and 43; 542 - fig. 5; the provisioning server stores services and features that a user may selectively provision onto their mobile communication device);

programming a mobile communication device to provide, on demand, a subset (516-fig. 5) of said superset (542-fig. 5) of features, (fig. 2; paragraphs 11 and 37);

receiving a request for accessing to a feature from said superset of features not included in said subset, said request being received from the mobile communication device via a wireless channel, (paragraphs 11 and 42); and

provisioning the requested feature to said mobile communication device, (paragraphs 11,43 and 46).

Regarding claim 2, Dusse teaches wherein said wireless channel comprises a digital control channel, (paragraphs 37 and 43).

Regarding claim 12, Dusse teaches a method for provisioning services to a mobile communication device, (abstract; paragraphs 11 and 47), comprising:

programming the mobile communication device to provide a first set of features (516-fig. 5) defining an aspect of a first service, (fig. 2; paragraphs 11 and 37; fig. 5 - 516);

programming a wireless network server to provide a second set of features, (542-fig. 5; paragraphs 11 and 43),

supplementing said first set, to fully define said first service, (paragraph 33);

receiving, at the mobile communication device, a command to access said first service, (paragraph 32 and 33);

responsive to said command, determining whether said first set of features can satisfy said command, (paragraphs 32-33, 42 and 43); and

if it is determined that said first set of features cannot satisfy said command then automatically transmitting a request to satisfy said command to said wireless network server, (paragraph 33).

Regarding claim 13, Dusse teaches wherein the request to satisfy said command is transmitted via a wireless digital control channel, (paragraphs 37 and 43).

Regarding claim 24, Dusse teaches a system for providing service features to a mobile communication subscriber, (abstract; paragraph 11) comprising:

a mobile communication network, (fig. 1);

a mobile network services server coupled to said mobile communication network, (figs. 1 and 4); and

a mobile communication device coupled to said mobile communication network via an over-the-air transmission path, (figs. 1 and 3), said mobile communication device including,

a processor, (fig. 3; paragraph 37); and

a memory coupled to said processor (fig. 3; paragraph 37) and storing therein a program to perform the operations of, generating a command for a communication service based on a subscriber inputs, (paragraphs 11 and 32);

determining whether said communication service can be satisfied by the mobile communication device as a stand alone device, and if it is determined that said mobile communication device cannot satisfy said communication service, then automatically transmitting a service request to said mobile network services server via said over-the-air transmission path, (paragraphs 32-33, 42 and 43).

Regarding claim 25, Dusse teaches wherein said over-the-air transmission path comprises a wireless digital control channel, (paragraphs 37 and 42).

Regarding claim 28, Dusse teaches wherein said communication service relates to a personal information management service, (paragraph 11).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 3-7,19 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dusse in view of Marwell et al. US Patent 6,668,055.

Regarding claim 3, while Dusse teaches of a subset of features defines a resident address book service which is stored at the mobile communication device and of provisioning resident features in a mobile communication device, Dusse does not specifically teach of the superset of features defines an address book.

However, Dusse suggests the features may include a plurality of different services and features and allowing a user to select features that is used for the device, therefore it would have

been obvious to include an address book so that the mobile device can be provisioned with features that are not initially provisioned in the device.

Nonetheless, Marwell teaches wherein a superset of features defines an address book service in the network and wherein a subset of features defines a portion of a user-defined address book to be stored at the mobile communication device, (col. 5, lines 24-51; col. 6, lines 3-52; the network stores the master copy (superset) of the address book an when the network address book is modified then the address book in the mobile device (portion of the address book) can be allow to receive the full modified address book from the network).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the provisioning service of Dusse to include an address book service in the network to be used by the device as suggested by Marwell so that the users address book can be provisioned to multiple telephony devices and all address books can easily be synchronized with the desired contact numbers.

Regarding claim 4, Dusse as modified by Marwell teach wherein the received request comprises a request for access to a portion of said user defined address book which is stored in the wireless network, (col. 5, lines 24-41, col. 6, lines 32-52; col. 11, lines 37-52).

Regarding claims 5 and 7, Dusse teaches wherein said wireless channel comprises a digital control channel, (paragraphs 37 and 42).

Regarding claim 6, Dusse as modified by Marwell, further teach receiving an update transmission from said mobile communication device to effect a modification of said user defined address book stored in the wireless network, (col. 5, lines 24-51col. 6, lines 32-52).

Regarding claims 19 and 27, Dusse, as applied above, does not teach the first service/communication service being an address book, however as explained above, it would have been obvious to include an address book based on the suggestion of storing a resident address book and provisioning resident features as suggested by Dusse.

Marwell, as shown above teaches that it was well known to have a first service to include an address book and to have a second service which also includes an address book in the network, (col. 5, lines 24-51; col. 6, lines 3-52).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the provisioning service of Dusse to include an address book service in the network to be used by the device as suggested by Marwell so that the users address book can be provisioned to multiple telephony devices and all address books can easily be synchronized.

8. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dusse in view of Marwell and further in view of Calder et al. US Patent Pub 2001/0034244.

Regarding claims 20 and 21, while Dusse in view of Marwell teaches of having address books in the network and in the mobile communication device, Dusse in view of Marwell do not specifically teach of having the address book comprise different portions.

Calder teaches that it was well known in the art to store a first portion of an address book in a mobile terminal (paragraphs 7,9,58,77-78) and to store second portion of an address book in a server so that a user can request the second portion of the address book on a as needed basis, (paragraphs 7,64-65).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Dusse and Marwell by having two different portions of address books as suggested by Calder so that a user can individually select from a list of numbers a specific list (e.g. fone list A, fone list B) that the users needs at that time while ensuring that the phone list will fit thee phone books memory.

Regarding claim 22, Dusse teaches wherein said mobile communication device queues said command and performs said step of transmitting when a communication path to said wireless network server becomes available, (paragraphs 32-33).

Regarding claim 23, Dusse teaches wherein the request to satisfy said command is transmitted via a wireless digital control channel, (paragraphs 37 and 42).

9. Claims 8-11,14-18 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dusse in view of Kahan et al. US Patent Pub. 2002/0024536.

Regarding claim 8, while Dusse teaches of providing a plurality of features for the mobile communication device, Dusse does not specifically teach of defining a calendar service.

Kahan teaches that it was well known in the art to have a calendar service stored in the network and to send the calendar to the mobile device. Kahan also teaches wherein a superset of features defines a calendar service and wherein said subset of features defines a portion of a user defined calendar to be stored at the mobile communication device, (paragraphs 6 and 58).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Dusse to include a calendar service to be included in the provisioning so that the mobile communication device can be provisioned with services that the user desires.

Regarding claims 9,11,14-16 and 26,, Dusse as modified by Kahan and as applied above, teach wherein said received request comprises a request for access to a portion of said user defined calendar which is stored in the wireless network, (paragraphs 6 and 58, Kahan); receiving an update transmission from said mobile communication device to effect a modification of said user defined calendar stored in the wireless network, (paragraphs 6 and 58, Kahan); wherein said first service/communication service comprises a calendar service having a plurality of scheduling options, (paragraphs 6 and 58); wherein said aspect of the first service comprises a monthly scheduler capable of handling a subset of the scheduling options in the calendar service, (paragraphs 6 and 58); and wherein said command requests to schedule an event outside of the scheduling options available with said aspect of the first service.

As stated above it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Dusse to include a calendar service to be included in the provisioning so that the mobile communication device can be provisioned with services that the user desires.

Regarding claim 10, Dusse teaches wherein said wireless channel comprises a digital control channel, (paragraphs 37 and 42).

Regarding claim 17, Dusse teaches wherein said mobile communication device queues said command and performs said step of transmitting when a communication path to said wireless network server becomes available, (paragraphs 32-33)).

Regarding claim 18, Dusse teaches wherein the request to satisfy said command is transmitted via a wireless digital control channel, (paragraphs 37 and 42).

Conclusion

10. Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9314, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262. The examiner can normally be reached on Monday to Friday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ovidio Escalante
Examiner
Group 2645
April 1, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600